

**REMARKS**

Upon entry of the Amendment, claims 1-8 are pending in the application. Claims 5-7 have been amended. Claim 8 is new. The specification supports new claim 8, such as on pages 7 to 8. No new matter has been added.

**II. Claim Rejections - 35 U.S.C. § 112**

Claims 5 and 6 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

The Examiner asserts that all types of *Pennicillium* cannot produce PF1270A substance, PF1270B substance, and PF1270C substance.

Claim 5 presently recites a strain belonging to the genus *Penicillium* and having the ability to produce the compound described in claim 1.

Claim 6 recites a strain PF1270 belonging to the genus *Penicillium*, which has the characteristic to produce a compound described in claim 1 and had been deposited as the deposition number FERM BP-08610 in International Patent Organism Depository, National Institute of Advanced Industrial Science and Technology, and a mutant thereof.

A person skilled in the art can culture a *Penicillium* strain having the ability to produce PF1270A substance, PF1270B substance, and PF1270C substance; and collect the compound without undue experimentation. The specification provides sufficient guidance for culturing the strain and collecting the compound.

A person skilled in the art can also select a *Penicillium* strain having the ability to produce a PF1270A substance, PF1270B substance, and PF1270C substance, without undue experimentation. The PTO has previously allowed United States Patent Numbers 5,789,602 and

6,432,978. These patents include claims drawn to a class of microorganisms producing a certain compound. United States Patent Numbers 5,789,602 and 6,432,978 are provided herewith for the convenience of the Examiner.

Claims 5-7 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

The Examiner asserts that claims 5-7 lack antecedent basis for the phrase “PF1270 A, B, and C substances described in claim 1.” Claims 5-7 have been amended to provide antecedent basis.

### **III. Claim Rejections - 35 U.S.C. § 102**

Claim 6 has been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 3,817,835 to Neidleman (“Neidleman ‘835”).

Additionally, claim 6 has been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 01/21607 (“WO ‘607”).

Claim 6 presently recites a strain PF1270 belonging to the genus *Penicillium*, which has the characteristic to produce a compound described in claim 1 and had been deposited as the deposition number FERM BP-08610 in International Patent Organism Depository, National Institute of Advanced Industrial Science and Technology, and a mutant thereof.

The Examiner asserts that each of Neidleman ‘835 and WO ‘607 describes the claimed strain PF1270. Example 22 of Neidleman ‘835 discloses *Penicillium waksmanii* (ATCC 10516). *See*, col. 7, lines 4-10. Examples 1 and 2 of WO ‘607 disclose a *Penicillium waksmani* mutant strain NCAIM (P)F001269. *See* pages 13-14.

The strain PF1270 and mutant thereof, as recited in claim 6, is different from *Penicillium waksmanii* (ATCC 10516) as disclosed in Neidleman ‘835 and from the *Penicillium waksmani*

mutant strain NCAIM (P)F001269, as disclosed in WO '607. Neidleman '835 and WO '607 fail to describe or suggest that the *Penicillium waksmanii* (ATCC 10516) and *Penicillium waksmani* mutant strain NCAIM (P)F001269 has the characteristic to produce PF1270A, B and C substances.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

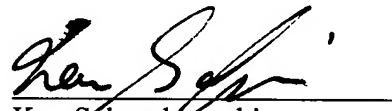
Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

**65565**

CUSTOMER NUMBER

  
Ken Sakurabayashi  
Registration No. 58,490

Date: June 27, 2007